

**REMARKS**

**I. Amendments to the Claims**

Claims 1 and 4 have been amended to incorporate the limitations of claims 2 and 6, respectively.

Claims 2 and 6 have been canceled.

Claims 3 and 7 have been amended to clarify that the claims are directed to an image forming system comprising an image-forming apparatus and a toner.

In the Advisory Action dated March 30, 2006, the Examiner states that the amendments to claims 3 and 7 raise the issue of new matter and rejections under 35 U.S.C. § 112, 1<sup>st</sup> paragraph for lack of written description regarding the newly added recitation of an "image forming system" in the originally filed specification. It is the Examiner's position that Applicants have not indicated where in the originally filed specification there is antecedent basis for the term "image forming system" and the proposed amendment also raises an issue under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph, because it is not clear what is meant by the term "system", which is not defined in the originally filed specification.

Applicants respectfully submit that the term "image forming system" is not new matter since it merely renames the invention as a system comprising an image forming apparatus and toner (see MPEP §2163.07(I)) and since the term "system", which is defined as a group of interrelated, interactive or interdependent constituents forming a complete whole or a functionally related group of elements (see Webster's II New College Dictionary, 3<sup>rd</sup> Ed.) is to be given its plain and ordinary meaning as would be understood by those of ordinary skill in the art. There is no question that the original specification adequately describes the recited

elements of the invention, and there is no legal requirement that the exact same phraseology be used in the claims, as in the specification, to comply with section 112's so-called written description requirement.

In response to the Advisory Action dated March 30, 2006, the status identifier for claim 7 is corrected as "currently amended".

No new matter has been added.

After entry of this amendment, claims 1, 3-5, and 7 will be pending in the application.

## **II. Response to Objections to the Disclosure**

At page 4, paragraph 4 of the Office Action, the disclosure is objected to because the substitute specification, filed September 28, 2005, does not incorporate the amendment filed on February 27, 2004, in which the second occurrence of figure number "1" was corrected to "2" at page 8, line 20 of the specification.

In response, Applicants have amended the September 28, 2005 substitute specification by correcting Fig. 1 to Fig. 2 at page 8, line 20.

Accordingly, Applicants respectfully request reconsideration and withdrawal of this objection.

## **III. Response to Claim Rejections Under 35 U.S.C. § 112, Second Paragraph**

In paragraph 6 at pages 4 and 5 of the Office Action, claims 3 and 7 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite.

Specifically, the Examiner states that claims 3 and 7 are indefinite because the structural relationship between the apparatus and the toner is not clear. The Examiner further states that it is not clear how an apparatus comprises a toner, since a toner is merely a material that is worked upon by an apparatus rather than a structural element of an apparatus.

In response, Applicants have amended claims 3 and 7 to clarify that the claims are directed to an "image forming system" comprising both the apparatus and the toner.

Applicants submit that claims 3 and 7 particularly point out and distinctly claim the subject matter which Applicants regard as the invention, and thus respectfully request reconsideration and withdrawal of this rejection.

#### **IV. Response to Claim Rejections Under 35 U.S.C. §§ 102(b) and 103(a)**

At pages 5-9 of the Office Action, claims 1, 4, and 5 are rejected under 35 U.S.C. § 102(b) as allegedly anticipated by, or in the alternative under 35 U.S.C. § 103(a) as allegedly obvious over, WO 02/084408 A1.

Applicants have amended claims 1 and 4 to incorporate the limitations of claims 2 and 6, respectively. Because claims 2 and 6 are not included in this rejection, such amendment should be sufficient to overcome this rejection.

Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection.

**V. Response to Claim Rejections Under 35 U.S.C. § 103(a)**

At pages 9-11 of the Office Action, claims 3 and 7 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Pat. No. 6,748,192 B2 (Izawa) combined with Matsumura.

The Examiner concedes that Izawa does not exemplify the particular toners recited in the instant claims, but contends that the reference discloses an electrophotographic image forming apparatus that meets all of the other structural requirements recited in instant claims 3 and 7. The Examiner further contends that the reference does not limit the type of toner used. In addition, the Examiner states that the fixing unit of the reference apparatus is effective for oil-less fixing. Thus, the Examiner concludes that it would have been obvious for a person having ordinary skill in the art, in view of the teachings of Matsumura, to use the toner disclosed by Matsumura as the toner in the developing unit of the image forming apparatus disclosed by Izawa.

Applicants have amended claims 3 and 7 to recite image forming systems comprising the toners recited in claims 1 and 4, respectively. Applicants submit that Matsumura does not teach or suggest the recited toners.

Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection.

**VI. Response to Claim Rejections Under 35 U.S.C. § 102(e)**

At pages 11-14 of the Office Action, claims 1-7 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Pat. Publication No. 2005/0100807 A1 (Yamazaki).

In response, Applicants respectfully request that the Examiner enter and consider the verified English translations of Japanese Patent Application Nos. 2003-053833 and 2003-053834 previously submitted to the U.S. PTO on March 16, 2006, to thereby perfect their claim to priority under 35 U.S.C. § 119(a) and antedate the Yamazaki reference, published May 12, 2005 and filed in the U.S. on October 20, 2003.

Support for claims 1, 3-5, and 7 is shown in the Table below. All references are to claim, page, and paragraph numbers of the verified English translations.

| <u>Claim</u> | <u>JPA No. 2003-053833</u>                               | <u>JPA No. 2003-053834</u>                              |
|--------------|--|---|
| 1            | Claims 1 and 2; para. 15 at p. 8 and para. 25 at page 12 |   |
| 3            | Claims 1-3; and para. 15 at p. 8                         |   |
| 4            |  | Claims 1 and 3; para. 17 at p.8 and para. 27 at page 12 |
| 5            |  | Claims 1-3; and para. 17 at p.8                         |
| 7            |  | Claims 1-4; and para. 17 at p.8                         |

Claims 2 and 6 have been canceled, rendering this rejection moot as to these claims.

In the Advisory Action dated March 30, 2006, the Examiner states that the foreign priority documents submitted on March 16, 2006 do not provide support for the recitation of a "block polyester" as broadly recited in claims 1 and 4. It is the Examiner's position that the priority documents provide support for "a block polyester comprising a crystalline part and an amorphous part". In response, Applicants refer the Examiner to paragraph [0025] of the previously submitted English translation of JP '833 and paragraph [0027] of the previously

submitted English translation of JP '834, which provides support for the subject matter recited in the present claims.

Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection.

## **VII. Response to Double-Patenting Rejections**

**A.** At pages 14 to 18 of the Office Action, claims 1 and 2 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being allegedly unpatentable over claims 1-8 of copending Application No. 10/787,147.

**B.** At pages 18 to 21, claims 4-6 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of copending Application No. 10/787,147.

In response, Applicants submit herewith a Terminal Disclaimer, thereby obviating the obviousness-type double patenting rejections.

Accordingly, Applicants respectfully request withdrawal of the rejections.

## **VIII. Conclusion**

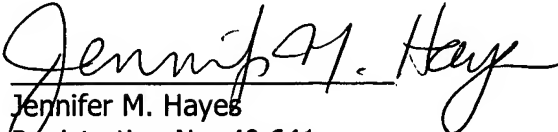
In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Amendment under 37 C.F.R. §1.114(c)  
U.S. App. Ser. No. 10/787,099

Atty. Dckt. No. Q80152

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

  
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**23373**

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